

| | |
|---|-----------|
| I. REAL PARTY IN INTEREST | 1 |
| II. RELATED APPEALS AND INTERFERENCES | 1 |
| III. STATUS OF CLAIMS..... | 2 |
| IV. STATUS OF AMENDMENTS..... | 2 |
| V. SUMMARY OF CLAIMED SUBJECT MATTER..... | 2 |
| VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL..... | 3 |
| VII. ARGUMENT..... | 4 |
| VIII. CLAIMS APPENDIX | 10 |
| IX. EVIDENCE APPENDIX | 15 |
| X. RELATED PROCEEDINGS APPENDIX | 16 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

| | | |
|-------------------------------------|---|---------------------------|
| In re Application of | : | Customer Number: 46320 |
| | : | |
| Kwasi ASARE, et al. | : | Confirmation Number: 5007 |
| | : | |
| Application No.: 10/725,612 | : | Group Art Unit: 2191 |
| | : | |
| Filed: December 2, 2003 | : | Examiner: Q. Chen |
| | : | |
| For: OPTIMAL COMPONENT INSTALLATION | : | |

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed March 29, 2007, wherein Appellants appeal from the Examiner's rejection of claims 1-2, 4, 6-8, 10-11, 13, and 15.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on April 26, 2004, at Reel 014563, Frame 0854.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-2, 4, 6-8, 10-11, 13, and 15 are pending and finally rejected in this Application. Claims 3, 5, 9, 12, and 14 have been cancelled. It is from the final rejection of claims 1-2, 4, 6-8, 10-11, 13, and 15 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Second Office Action dated December 29, 2006 (hereinafter the Second Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figure 3 and to independent claims 1 and 10, a component installation method is disclosed. In block 310, target platform requirements for installation of a subject application component within a target specific installation script are identified (lines 4-6 of paragraph [0027] of Appellants' disclosure). In block 325, a listing of dependencies for the subject application and at least one specified relationship between the subject application and individual ones of the dependencies are identified (lines 1-3 of paragraph [0028]). In blocks 320 and 335, both the target platform requirements and the at least one specified relationship are enforced prior to installing the subject application component in block 350 (see Figure 3). In blocks 345 and 365, the installation is aborted where either one of the target platform requirements and the at least one specified relationship cannot be enforced (lines 7-10 of paragraph [0029]). In block 320, whether all required ones of the dependencies can be accessed in the target platform are determined (lines 7-10 of paragraph [0027]). In block 340, for each required one of the dependencies which cannot be accessed in the target platform, the required

one of the dependencies in the target platform are located and installed (lines 5-7 of paragraph [0029]) and dated ones of the required ones of the dependencies which can be accessed in the target platform are updated with updated versions of the required ones of the dependencies (lines 1-3 of paragraph [0026]).

Referring to Figure 2 and to independent claim 7, a system for installing application components 220 in a target platform 240 is disclosed. The system includes a component installation engine 200, a script processor 200, and a requirements verification processor 200. The component installation engine 200 installs application components 220 and respective dependencies 230 over a component distribution system (lines 6-9 of paragraph [0026]), and the component installation engine 200 includes a communicative coupling to a repository 250 of updated ones of the dependencies 260 (lines 4-7 of paragraph [0025]. The component installation engine 200 also updates dated ones of the dependencies 230 with the updated ones of the dependencies 260 prior to installing the application components 220 (lines 1-3 of paragraph [0026]). The script processor 200 is coupled to the engine 200 and parses target specific installation scripts 210 to identify both a listing of dependencies 230 for the application components 220 and at least one specified relationship between the application components 220 and individual ones of the respective dependencies 230 (lines 1-4 of paragraph [0025]). The requirements verification processor 200 enforces both target platform requirements for installing the application components 220 and the at least one specified relationship prior to installing the application components 220 (lines 5-7 of paragraph [0024]).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 7 and 8 were rejected under 35 U.S.C. § 101; and

2. Claims 1-2, 4, 6-8, 10-11, 13, and 15 were rejected under 35 U.S.C. § 103 for obviousness based upon Zimmiewicz et al., U.S. Patent No. 6,744,450 (hereinafter Zimmiewicz), in view of Donohue, U.S. Patent No. 6,202,207.

VII. ARGUMENT

THE REJECTION OF CLAIMS 7 AND 8 UNDER 35 U.S.C. § 101

For convenience of the Honorable Board in addressing the rejections, and claim 8 stands or falls together with independent claim 7.

In the First Amendment dated October 25, 2006 (hereinafter the First Amendment), Appellants argued that independent claim 7 was directed to a system (i.e., a machine), and on this basis, claim 7 was directed to statutory subject matter. The Examiner response to this argument is found on page 13 of the Second Office Action and reproduced below:

a) Examiner disagrees. Claims 7 and 8 are directed to systems. However, the recited components of the systems appear to lack the necessary physical components (hardware) to constitute a machine or manufacture under § 101. A system without any hardware structure, such as processor and memory, cannot be defined as a machine or manufacture. All of the recited components of the system can be reasonably interpreted as computer program modules — software *per se*. Therefore, the claims are directed to systems of functional descriptive material *per se*, and hence non-statutory. See 35 U.S.C. § 101 rejection of Claims 7 and 8 above. (emphasis in original)

Based upon the Examiner's analysis, it is readily apparent that the Examiner misunderstands exactly what constitutes software *per se*. In particular, Appellants respectfully submit that the Examiner is confused as to exact meaning of the phrase "per se." The definition of "per se" is the following:¹

By itself; in itself; taken alone; by means of itself; through itself; inherently; in isolation; unconnected with other matters; simply as such; in its own natures without reference to its relation.

¹ Black's Law Dictionary 1142 (6th ed. 1990).

Thus, software *per se* is an abstract idea embodied by the software alone without anything else. For this reason, software *per se* is deemed to be non-statutory subject matter.

The claimed invention, however, is not directed to software *per se*, but instead, to a system. Moreover, the claimed system includes functional components (e.g., "a component installation engine configured to install application components," "a script processor ... programmed to parse target specific installation scripts," and "a requirements verification processor programmed to enforce both target platform requirements"). Software *per se* is incapable of being functional since software *per se* is unconnected to anything else. The claimed system, however, to be functional must be coupled physical components (i.e., hardware). Therefore, the claimed system constitutes statutory subject matter within the meaning of 35 U.S.C. § 101.

**THE REJECTION OF CLAIMS 1-2, 4, 6-8, 10-11, 13, AND 15 UNDER 35 U.S.C. § 103 FOR
OBVIOUSNESS BASED UPON ZIMNIEWICZ IN VIEW OF DONOHUE**

For convenience of the Honorable Board in addressing the rejections, and claims 2, 4, 6-8, 10-11, 13, and 15 stand or fall together with independent claim 1.

On page 12 of the First Amendment, Appellants presented the following arguments with regard to claims 1 and 10:

Applicants respectfully submit that even if one having ordinary skill in the art were motivated to modify Zimniewicz in view of Donohue, the claimed invention would not result. Independent claims 1 and 10 specifically recite the claimed enforcing step occurs "prior to installing said subject application component." Although Donohue teaches "applying updates to programs installed on the local system" (column 9, lines 48-49), Donohue is silent with regard to when the updating occurs during the installation of a subject application component. (emphasis in original)

The Examiner response to these arguments is found on page 14 of the Second Office Action in which the Examiner asserted "Donohue clearly discloses when the updating occurs during the installation of a subject application component" (emphasis in original). For support, the Examiner also cited column 5, lines 54-62, which is reproduced below:

An updater component according to a preferred embodiment of the invention performs a comparison between available software updates and installed software on the local computer system to identify which are relevant to the installed software, compares the available relevant updates with update criteria held on the local computer system (these update criteria are predefined for the current system or system user), and then automatically downloads and applies software updates which satisfy the predefined criteria.

At the outset, Appellants note that the Examiner's cited passage is found in the "Summary of Invention" section of Donohue and is not very clear as to its specific teachings. For example, Appellants are unclear as to exactly what feature in this passage allegedly corresponds to the claimed "subject application component," which is to be installed. The identification of this feature is critical because Appellants argument is that Donohue does not identify when the enforcing step occurs relative to when the subject application component is installed.

Notwithstanding the lack of clarity by the Examiner in identifying the feature in Donohue being relied upon to teach the claimed "subject application component," Appellants note that the above-cited passage twice refers to "installed software." This passage also teaches that available software updates for the installed software are compared with update criteria on a local computer system, and based upon this comparison, software updates that satisfied the criteria are downloaded.

Claims 1 and 10 recite that the step of updating is part of the step of enforcing, and thus, both steps are performed prior to installing the subject application component. However, the

software is not referred to in Donohue as "software to be installed," but instead as installed software. Thus, the software has already been installed. Presuming that the Examiner intends to allege that the "installed software" identified in this passage corresponds to the claimed "subject application component," then Donohue fails to teach or suggest the limitation at issue, which requires that the enforcing step be performed "prior to installing said subject application component." Instead, Donohue teaches that the updating occurs after the software has been installed. Thus, not only does Donohue fails to teach or suggest that the step of enforcing occurs prior to installing the subject application component, Donohue teaches away from this particular limitation.

On page 12 of the First Amendment, Appellants also argued that "Zimniewicz is also silent with regard to when any updating occurs." (emphasis in original). On page 14 of the Second Office Action, the Examiner responded to this argument by citing reference number 102 of Figure 3; column 9, lines 56-59, Figures 3 and 4a-4c, column 7, lines 9-13 and 15-19; column 8, lines 4-7; column 9, lines 46-48; and column 10, lines 15-19 and 23-24, while asserting the following:

Zimniewicz et al. clearly disclose when the updating occurs during the installation of a subject application component ... Zimniewicz et al. also disclose enforcing both said target platform requirements and said at least one specified relationship prior to installing said subject application component. (emphasis in original)

The Examiner has reproduced the above-cited passages on pages 14 and 15 of the Second Office Action, with the exception of column 9, lines 56-59, which is reproduced below:

The Setup Manager also installs 102, when necessary, components needed to achieve the scenario baseline if it differs from the suite baseline.

As evident from reviewing all of the Examiner's cited passages, none of these passages refer to updating. The Examiner admits as much on pages 6 and 7 of the Second Office Action when the Examiner states that "Zimniewicz et al. do not disclose - updating dated ones of said required ones of said dependencies which can be accessed in said target platform with updated versions of said required ones of said dependencies" (emphasis in original).

Therefore, not only does Zimniewicz fail to teach or suggest updating, as claimed, Donohue teaches away from the claimed limitation by teaching that updating occurs after the software has been installed. Therefore, even if one having ordinary skill in the art were motivated to modify Zimniewicz in view of Donohue, the claimed invention, as recited in claims 1 and 10, would not result. Similarly, independent claim 7 recites that the component installation engine updates dated ones of the dependencies with updated ones of the dependencies prior to installing application components; and thus, the combination of Zimniewicz and Donohue also fails to teach or suggest the limitations recited in claim 7.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections under 35 U.S.C. §§ 101, 103 are not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. §§ 101, 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in

Application No.: 10/725,612

connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: March 29, 2007

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

CUSTOMER NUMBER 46320

VIII. CLAIMS APPENDIX

1. A component installation method comprising the steps of:

identifying target platform requirements for installation of a subject application component within a target specific installation script;

further identifying a listing of dependencies for said subject application and at least one specified relationship between said subject application and individual ones of said dependencies;

enforcing both said target platform requirements and said at least one specified relationship prior to installing said subject application component; and,

aborting said installation where either one of said target platform requirements and said at least one specified relationship cannot be enforced, wherein said enforcing step comprises the steps of

determining whether all required ones of said dependencies can be accessed in said target platform,

for each required one of said dependencies which cannot be accessed in said target platform, locating and installing said required one of said dependencies in said target platform, and

updating dated ones of said required ones of said dependencies which can be accessed in said target platform with updated versions of said required ones of said dependencies.

2. The method of claim 1, wherein said further identifying step comprises the step of further identifying a listing of dependencies for said subject application and at least one specified

relationship between said subject application and individual ones of said dependencies, wherein said at least one specified relationship is a relationship selected from the group consisting of a containment relationship, a usage relationship, a contradictory relationship and an equivalence relationship.

4. The method of claim 1, wherein said determining step comprises the step of querying a registry of installed components in said target platform to identify components which have been installed in said target platform.

6. The method of claim 1, wherein said enforcing step further comprises the step of patching flawed ones of said required ones of said dependencies which can be accessed in said target platform with updated versions of said required ones of said dependencies.

7. A system for installing application components in a target platform, the system comprising:

a component installation engine configured to install application components and respective dependencies over a component distribution system, the component installation engine including a communicative coupling to a repository of updated ones of said dependencies;

a script processor coupled to said engine and programmed to parse target specific installation scripts to identify both a listing of dependencies for the application components and at least one specified relationship between the application components and individual ones of said respective dependencies; and,

a requirements verification processor programmed to enforce both target platform requirements for installing the application components and said at least one specified relationship prior to installing the application components, wherein

the component installation engine updates dated ones of said dependencies with said updated ones of said dependencies prior to installing said application components.

8. The system of claim 7, wherein said at least one specified relationship comprises a relationship selected from the group consisting of a containment relationship, a usage relationship, a contradictory relationship and an equivalence relationship.

10. A machine readable storage having stored thereon a computer program for component installation, the computer program comprising a routine set of instructions which when executed by the machine cause the machine to perform the steps of:

identifying target platform requirements for installation of a subject application component within a target specific installation script;

further identifying a listing of dependencies for said subject application and at least one specified relationship between said subject application and individual ones of said dependencies;

enforcing both said target platform requirements and said at least one specified relationship prior to installing said subject application component; and,

aborting said installation where either one of said target platform requirements and said at least one specified relationship cannot be enforced, wherein said enforcing step comprises the steps of

determining whether all required ones of said dependencies can be accessed in said target platform,

for each required one of said dependencies which cannot be accessed in said target platform, locating and installing said required one of said dependencies in said target platform, and

updating dated ones of said required ones of said dependencies which can be accessed in said target platform with updated versions of said required ones of said dependencies.

11. The machine readable storage of claim 10, wherein said further identifying step comprises the step of further identifying a listing of dependencies for said subject application and at least one specified relationship between said subject application and individual ones of said dependencies, wherein said at least one specified relationship is a relationship selected from the group consisting of a containment relationship, a usage relationship, a contradictory relationship and an equivalence relationship.

13. The machine readable storage of claim 10, wherein said determining step comprises the step of querying a registry of installed components in said target platform to identify components which have been installed in said target platform.

15. The machine readable storage of claim 10, wherein said enforcing step further comprises the step of patching flawed ones of said required ones of said dependencies which can be accessed in said target platform with updated versions of said required ones of said dependencies.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.